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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/762,513

01/23/2004

Richard F. Schroeder

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EXAMINER

OROPEZA, FRANCES P

ART UNIT

PAPER NUMBER

3766

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/762,513	<b>Applicant(s)</b> SCHROEDER ET AL.	
	<b>Examiner</b> FRANCES P. OROPEZA	<b>Art Unit</b> 3766	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 3/4/08 (Election).
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 64-70,73-76,78-91,94-102 and 104-115 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 64-70,73-76,78-91,94-102 and 104-115 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/12/07</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Interview Summary***

1. In a conversation with the Applicant documented in the Interview Summary mailed 2/20/08, the Examiner indicated the Applicant should expect an Office action toward the end of February (2008) in response to the Applicant's Amendment of 12/5/07. The promised Office action was written by the Examiner and signed by the Supervisor Patent Examiner, but was electronically returned to the Examiner by the group responsible for mailing the actions. The Examiner was on extended holiday and returned to the Office the first of April. Given the Office electronic action system was newly installed, the Examiner was not aware the Office action was not sent until late April. By that time, the Applicant had filed a response that out dated the February Office action. The Applicant's response of 3/4/08 was entered into the Examiner's docket and this Office action is written in response to that amendment.

### ***Election/ Restriction***

2. The Applicant cancelled all the claims not associated with the elected species of Figures 5A and 5B in the response filed 3/4/08, and identified the claims readable on the elected embodiment as claims 64-70, 73-76, 78-91, 94-102 and 104-115.

### ***Claim Rejections - 35 USC § 101***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined

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application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 64 is rejected on the ground of nonstatutory double patenting over claims 60-68 of U. S. Patent No. 6,162,168 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: Although the conflicting claims are not identical, they are patentably distinct from each other because the intended use of the devices, not causing a bifurcation of the chamber, is taught or is capable of being preformed by the conflicting device.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

5. Claims 64, 69, 70 and 73 are rejected on the ground of nonstatutory double patenting over claim 1 U. S. Patent No. 6,261,222 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: Although the conflicting claims are not identical and the affixing member is not detail in the patent, the specific affixation, a lockable mechanism, is well known in the art.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

6. Claims 64, 67, 69, 70 and 73 are rejected on the ground of nonstatutory double patenting over claims 12, 13 and 18-20 of U. S. Patent No. 6,514,194 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: Although the conflicting claims are not identical and the connector is not detail in the patent, the specific connector, a lockable mechanism, is well known in the art.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application

which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).  
See also MPEP § 804.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 64-70, 73-76, 78-91, 94-102 and 104-115 are rejected under 35 U.S.C. 102(b) as being anticipated by Schweich, Jr. et al. (U.S. Patent No. 5,961,440). Schweich et al. substantially disclose the instant invention, the apparatus (Figures 14, 16) and method comprising a first and second anchor (Figure 14, 16), a flexible connection member/ runner/ splint (150) that is selectively adjustable along the lever members (154) to alter the position of the anchors, an elongate member/ tension member (156) traversing the heart chamber and secured by the anchoring members, and a structure/ anchor (254, 256, 258) with a locking mechanism which protrudes from the connection member to secure the device to the epicardium of the heart. Numerous seeming interchangeable anchoring mechanisms (20, 310, 320, 410 and so on) are disclosed by Schweich, Jr. et al.. The locking mechanism associated with the anchor is accept to take many form known in the art such as a locking mechanism comprising a pin that can penetrate the connection member. The device is read to provide force on the heart including the atrio-ventricular (tricuspid) valve such that the cardiac tissue is impacted and repositioned enabling that the heart to beat more efficiently and effectively. While the valve altered by the

device of Figure 14 is accept to be the atrio-ventricular (tricuspid) valve, it is accepted relocating the device on the heart would enable the device to impact the mitral valve (Figures 14, 16; column 6, lines 14-15; column 7, lines 5-27).

### ***Specification***

9. The specification is objected to because on page 19, line 14 of the specification reference is made to a Figure 3d, and it appears there is no Figure 3d. Appropriate correction is required.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fran Oropeza whose telephone number is (571) 272-4953. Fran's schedule typically is Monday and Tuesday 9AM-7PM EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl. H. Layno can be reached on (571) 272-4949. Carl's schedule typically is Monday, Wednesday, Friday 9AM-5 PM EST; Tuesday, Thursday 9AM-3PM and 9PM-11PM EST. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communication and for After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Frances P. Oropeza/

Patent Examiner, Art Unit 3766

/Carl H. Layno/

Supervisory Patent Examiner, Art Unit 3766